REMARKS

No claims are amended or canceled, and no claims are added; as a result, claims 1-46 remain pending in this application.

As per request of Mr. Emanuel of the USPTO, enclosed is a copy of the prior Office Action.

Information Disclosure Statement

Applicant submitted an Information Disclosure Statement and a 1449 Form on January 8, 2003 and Supplemental Information Disclosure Statements and 1449 Forms on June 4, 2003 and February 17, 2004. Applicant further files a Supplemental Information Disclosure Statement herewith. Applicant respectfully requests that initialed copies of the 1449 Forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

Reservation of the Right to Swear Behind References

Applicant maintains its right to swear behind any documents which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited documents are not to be interpreted as admissions that the documents are prior art.

§102 Rejection of the Claims

Claims 1-3, 6-17, 20-26, 28-41, 43, 44 and 46 were rejected under 35 USC § 102(a) as being anticipated by Nelson et al. (U.S. Patent No. 6,564,104). Applicant respectfully traverses as a *prima facie* case of obviousness has not been made.

Applicant does not admit that Nelson is prior art, and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are distinguishable over Nelson for the reasons argued below.

The Office Action, at page 2, states "Claims 1-3, 6-17, 20-26, 28-41, 43, 44 and 46 are rejected . . . as being clearly anticipated by Nelson et al #6564104." Applicant notes that the Office Action, subsequently at page 2, identifies the device programmer as 112+ in Nelson.

RESPONSE UNDER 37 CFR § 1.111
Serial Number: 10/008,354
Filing Date: November 7, 2001
Title: CENTRALIZED MANAGEMENT SYSTEM FOR PROGRAMMABLE MEDICAL DEVICES

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Applicant respectfully submits that the element 112 in Nelson is the implantable medical device and not a device programmer. Applicant requests clarification of this interpretation of Nelson.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. In re Dillon 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Claim 1 recites, in part, a medical device programmer coupled to the network and configured to communicate at least one characteristic of a patient to the central server via the network, to receive at least one programmable parameter from the central server via the network, and to program the medical device using the at least one programmable parameter. Applicant can not find all of these features in Nelson. Nelson appears to teach a programmer 320, see Fig. 3 of Nelson. Fig. 3 of Nelson appears to be the only figure that shows a programmer. However, applicant can not find where Nelson describes all of the features of a programmer that are recited in claim 1. Specifically, the undersigned can not find any disclosure related to the Fig. 3 embodiment of Nelson that teaches or suggests a medical device programmer configured to communicate at least one characteristic of a patient to the central server via the network, to receive at least one programmable parameter from the central server via the network, and to program the medical device using the at least one programmable parameter as stated in claim 1. As a result, applicant respectfully submits that claim 1 and claims 2-14 depending from claim 1 are allowable over Nelson.

Claim 15 recites, in part, at least one prescription system coupled to the network interface, each configured to receive at least one characteristic of a patient from the medical device programmer via the network, to prescribe at least one programmable parameter of a medical device based on the at least one characteristic of the patient, and to transmit the at least one prescribed programmable parameter to the medical device programmer via the network. Applicant can not find all of these features in Nelson. However, applicant can not find where Nelson describes all of the features of a prescription system that are recited in claim 15. As a result, applicant respectfully submits that claim 15 and claims 16-24 depending from claim 15 are allowable over Nelson.

Claim 25 recites, in part, a processor coupled to the network interface and the medical device interface, and configured to communicate at least one characteristic of a patient to the

central server via the network, to receive at least one prescribed programmable parameter of the medical device from the central server via the network, and to program the medical device using the at least one prescribed programmable parameter via the medical device interface. Applicant can not find all of these features in Nelson. However, applicant can not find where Nelson describes all of the features of a prescription system that are recited in claim 25. As a result, applicant respectfully submits that claim 25 and claims 26-34 depending from claim 25 are allowable over Nelson.

Claim 35 recites, in part, determining at least one programmable parameter for a medical device based on the at least one characteristic using a prescription system hosted by the central server; communicating the at least one programmable parameter to the programmer; and programming the medical device using the at least one programmable parameter. Applicant can not find all of these features in Nelson. However, applicant can not find where Nelson describes all of the features of a prescription system that are recited in claim 35. As a result, applicant respectfully submits that claim 35 and claims 36-46 depending from claim 35 are allowable over Nelson.

§103 Rejection of the Claims

Claims 4, 5, 18, 19, 27, 42 and 45 were rejected under 35 USC § 103(a) as being unpatentable over Nelson (U.S. Patent 6,564,104) in view of Failandier (U.S. Patent No. 5,800,473). Applicant respectfully traverses as a *prima facie* case of obviousness has not been presented in the Office Action.
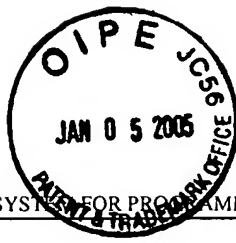
MPEP §2143 states

> "To establish a prima facie case of obviousness, three basic criteria must be net. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (fed. Cir. 1991)"

The Office Action fails to provide a motivation to combine Nelson and Filandier. As such a *prima facie* case of obviousness has not been made. Reconsideration and allowance of claims 4, 5, 18, 19, 27, 42 and 45 are requested.

Moreover, claims 4, 5, 18, 19, 27, 42 and 45 are dependent claims and are allowable with their respective parent claims.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
JULIO C. SPINELLI ET AL.
By their Representatives,
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Date 3 Jan '05 (Monday) By _____
                          Timothy B Clise
                          Reg. No. 40,957

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of January, 2005.

Name

Signature